

REMARKS

Claims 1-30 remain pending in the instant application. Claims 15-20 and 25-30 are withdrawn from consideration. Claims 1-14 and 21-24 presently stand rejected. Reconsideration of the pending claims are respectfully requested.

Claim Rejections – 35 U.S.C. § 112

Claims 1-14, 21-24 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Office Action alleges that the specification does not support network port authentication during the pre-boot phase as currently claimed and that while the specification discloses that authentication credentials are retrieved/generated during the pre-boot phase, the actual network port authentication does not occur until the operating system has actually booted and is running. Applicants respectfully traverse these allegations for at least the following reasons.

The Office Action asserts: “The specification does not support network port authentication during the pre-boot phase as currently claimed.” In contrast, **original** claim 2 recites: “The method of claim 1, wherein the network port is authenticated during a pre-boot phase.” With the teaching of the original specification (including original claim 2), one of ordinary skill in the art would thus have known that the inventor(s) would have had possession of the claimed invention “wherein the network port is authenticated during a pre-boot phase.”

Paragraph 67 of the instant specification recites (in relevant part): “In accordance with another aspect of the invention, a ‘mixed’ authentication scheme may be implemented, wherein firmware supports port authentication during pre-boot...” This citation demonstrates to one skilled in the relevant art that the inventors had possession of the claimed invention because, as conveyed in a described embodiment, the firmware (which is typically persistent memory and OS-independent) is used to support authentication in a pre-boot (e.g., pre-OS execution) environment.

The Office Action further alleges: “[T]he specification discloses that authentication credentials are retrieved/generated during the pre-boot phase, but the actual network port authentication does not occur until the operating system has actually

booted and is running.” The Applicants respectfully traverse this reasoning as being a false dilemma because the “actual” network port authentication (performed when an OS is running) is not necessarily mutually exclusive of authenticating the network port during a pre-boot phase. As stated above, original claim 2 recites the network port is authenticated during a pre-boot phase and paragraph 67 teaches a “mixed” authentication scheme wherein the firmware supports port authentication during pre-boot. Accordingly the specification as originally filed reasonably conveys to one skilled in the relevant art that the inventors had possession of the claimed invention. Accordingly, applicants believe the above-listed independent and depending claims are allowable under § 112.

With respect to claim 3, the Office Action asserts that the claim is indefinite because it is unclear whether or not the claimed operating system is the same operating system claimed in claim 1. Applicants respectfully traverse this assertion because the claim recites an operating system image that is loaded into the suppliant system over a network that is accessed via the network port that is authenticated. It is a possibility that the load operating system image can be the same operating system as claimed in claim one, but the claim language is not necessarily limited to this construction because the claimed operating system image is expressly limited to an operating system image that is loaded into the suppliant system over a network that is accessed via the network port that is authenticated. Accordingly, applicants believe claim 3 is allowable under § 112.

With respect to claim 4, the Office Action asserts that the claim directly contradicts claim 1 because claim 4 requires the network ports to be authenticated during the operating system runtime phase, whereas claim 1 requires the network port to be authenticated prior to booting of the operating system. As discussed above, Applicants respectfully traverse this assertion because authentication during the operating system runtime phrase is not necessarily mutually exclusive of authentication of the network port prior to booting of the operating system. Claim 1 itself recites passing the authentication credentials (used for authentication during the pre-boot phase) to the booted operating system. Thus, claim 1 does not contradict claim 4. Accordingly, applicants believe claim 4 is allowable under § 112.

Claim Rejections – 35 U.S.C. § 103

Claims 1-4, 9-14, 21, 22, 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Roese (US 2004/0158735) in view of Buer (US 2004/0250126).

Claims 5-8, 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Roese in view of Buer, and further in view of Cotichini (US 6,300,863).

“All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03.

As stated by the Office Action, Roese does not specify port authentication using an access/challenge scheme. Thus, Roese does not teach wherein the network port is authenticated during the pre-boot phase using authentication credentials. The Office action asserts Buer to attempt to make up for the deficiencies of Roese. The Office Action asserts the following: Buer teaches retrieving credentials from the TPM, which meets the limitation of passing the authentication credentials to the booted operating system, using the passed authentication credentials and the booted operating system to perform a port authentication process wherein the port is authenticated using an access/challenge scheme, wherein the access/challenge scheme employs a TLS challenge response in which authentication is determined based on credentials provided by the supplicant system, wherein the TLS challenge response employs credentials stored in a TPM, and wherein the method further comprises retrieving the credential from the TPM.

Applicants traverse this assertion because Buer [in paragraph 0026] includes a secure boot process in advance of subsequent security processing. The typical security processing includes the receipt, by the online TPM, of one or more commands from an application. The online TPM then proxies out the commands to the security module. As the security module completes execution of a command, the results and any related status information are returned to the online TPM. Thus, the TPM of Buer proxies commands from the application and does not pass the authentication credentials to the booted operating system and use the passed authentication credentials and the booted

operating system to perform a port authentication process. Accordingly claim 1 is submitted to be allowable.

The Office Action further asserts it would have been obvious to one of ordinary skill in the art at the time the invention was made for the authentication scheme of Roesse to utilize the TPM and TLS protocol as described by Buer in order to allow direct communication with the network while circumventing the TCP/IP stack at the client machine as taught by Buer. Applicants traverse the combination of references because the Office has erred substantively as to the factual findings. The factual findings of the Office Action fail to properly and objectively resolve the level of ordinary skill in the art to which the invention pertains at the time of the invention. The Office Action maintains in the Response to Arguments that applicant's arguments against the § 103 rejections are not persuasive because the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) that are applied for establishing a background for determining obviousness under 35 U.S.C. §103(a) have been fully set forth. This assertion without more appears to be (self-)conclusory.

Notwithstanding the applicability of Roesse and Buer as 102(e)-type art (if any), the mere recitation of such 102(e)-type art fails to objectively resolve the level of ordinary skill in the art to which the invention pertains at the time of the invention because both (as the record demonstrates) Buer was published (December 9, 2004) and Roesse was published (August 12, 2004) after the filing date of the instant invention (November 12, 2003).

Thus, the mere recitation of the references does not establish what was known by one of ordinary skill in the art at the time of the inventions because the record demonstrates the relied-upon references were not, (1) published, and thereby known by one of ordinary skill in the art at the time of the invention, or (2) invented and patent-applied-for by one of ordinary skill in the art at the time of the invention (as discussed below, the references do not establish that the inventors of the references were not geniuses in the art at hand). Thus, the cited art does not itself objectively determine the appropriate level of the level of ordinary skill in the art at the time of the invention. Without more evidence, there is no affirmative showing from the references that is sufficient to objectively resolve the level of ordinary skill in the art at the time of the

invention. With no affirmative showing, no prima facie case has been established, even when applying a preponderance of the evidence standard.

MPEP 2141.03 section III states in relevant part:

The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry." *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718, 21 USPQ2d 1053, 1057 (Fed. Cir. 1991). The examiner must ascertain what would have been obvious to one of ordinary skill in the art at the time the invention was made, and not to the inventor, a judge, a layman, those skilled in remote arts, or to geniuses in the art at hand. *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1983), cert. denied, 464 U.S. 1043 (1984)(emphasis added).

Applicants submit that the recitation of unpublished art does not properly and objectively resolve the level of skill of a person having ordinary skill in the relevant art at the time of the invention. In contrast, the unpublished material is (instead) held to be in confidence by the USPTO. Further, the response does not establish that Buer (and/or Roesse) is a person having ordinary skill in the relevant art at the time of the invention, and does not establish, for example, that he (or they) is not one of the "geniuses in the art at hand" (id.). Accordingly, Applicants respectfully submit that the Office Action has not established a prima facie case of obviousness.

Further to establishing a prima facie case of obviousness, MPEP 2141 Section II states in relevant part:

As reiterated by the Supreme Court in KSR, the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Court are as follows:

(A) Ascertaining the differences between the claimed invention and the prior art; and [sic]

(B) Ascertaining the differences between the claimed invention and the prior art; [sic] and

(C) Resolving the level of ordinary skill in the pertinent art (emphasis added).

Additionally, MPEP 2141 Section II states in relevant part:

Office personnel fulfill the critical role of factfinder when resolving the Graham inquiries. It must be remembered that while the ultimate determination of obviousness is a legal conclusion, the underlying Graham inquiries are factual. When making an obviousness rejection, Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied. In certain circumstances, it may also be important to include explicit findings as to how a person of ordinary skill would have understood prior art teachings, or what a person of ordinary skill would have known or could have done. Factual findings made by Office personnel are the necessary underpinnings to establish obviousness.

Once the findings of fact are articulated, Office personnel must provide an explanation to support an obviousness rejection under 35 U.S.C. 103. 35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed. Clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability.

In short, the focus when making a determination of obviousness should be on what a person of ordinary skill in the pertinent art would have known at the time of the invention, and on what such a person would have reasonably expected to have been able to do in view of that knowledge. This is so regardless of whether the source of that knowledge and ability was documentary prior art, general knowledge in the art, or common sense" (emphasis added).

Here, Buer and Roese are documentary prior art, and the mere recitation of documentary prior art (such as documentary prior art that was held in confidence by the USPTO at the time of the invention) does not properly determine what a person of ordinary skill in the pertinent art would have known at the time of the invention, and what that person would have reasonably expected to have been able to do with that knowledge. Accordingly, applicants respectfully submit that the Office Action has not established a prima facie case of obviousness because of a failure to maintain objectivity by properly resolving the level of skill of a person having ordinary skill in the relevant art at the time of the invention.

MPEP 2141.03 Section I states in relevant part that references which do not qualify as prior art because they postdate the claimed invention may be relied upon to show the level of ordinary skill in the art at or around the time the invention was made. *Ex parte Erlich*, 22 USPQ 1463 (Bd. Pat. App. & Inter. 1992). However, Applicants note the citation is a headnote, and not a citation of the text of the Opinion. The Opinion in relevant part states: “As recognized by the examiner, the [cited] publication itself is not prior art against the present claims. However, the reference does cite a large number of references bearing [earlier] reference dates.” *Id.*, 1465. Here, the facts of the instant record are distinguished from *Ex parte Erlich* because the reference in *Erlich* was a peer reviewed academic journal (which is disseminated information) as compared the instant case where the Examiner holds both Roese and Buer to be prior art. Instead, both Roese and Buer are post-dated published patent applications (which are held in confidence by action of law). Thus, *Erlich* is inapposite because the record shows the teachings of the post-dated references were held in confidence by the Office and were not disseminated (to those of ordinary skill in the art at the time of the invention, for example).

Even if the headnote of *Erlich* is an accurate restatement of the holding of *Erlich*, the non-judicial holding in *Erlich* must be interpreted in light of (judicial) case law and thus does not absolve the Office from following judicial case law (such as *Environmental Designs, Ltd.*) as discussed above. For example, the instant Office Action has not determined that the inventors of the cited art (which was held in confidence at the filing date of the instant invention) are people of ordinary skill (and are not “geniuses”). Accordingly, the Office is not absolved from the duty to objectively determine the level of ordinary skill in the (relevant) art at the time of the invention.

Consequently, the cited references (either singly or in fairly motivated combination) fails to teach or fairly suggest all elements of claim 1 as required under M.P.E.P. § 2143.03. Claim 21 is at least allowable for the reasons stated above. Dependent claims are allowable because they depend from allowable independent claims. For at least the reasons discussed above, applicants request that the instant §103(a) rejections be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, it is believed that the applicable rejections have been overcome and all claims remaining in the application are presently in condition for allowance. Accordingly, favorable consideration and a Notice of Allowance are earnestly solicited. The Examiner is invited to telephone the undersigned representative at (206) 292-8600 if the Examiner believes that an interview might be useful for any reason.

CHARGE DEPOSIT ACCOUNT

It is not believed that extensions of time are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a). Any fees required therefore are hereby authorized to be charged to Deposit Account No. 02-2666. Please credit any overpayment to the same deposit account.

Respectfully submitted,

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/Kandice D. Austin/
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November 3, 2008
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